

ESTTA Tracking number: **ESTTA795482**

Filing date: **01/17/2017**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86454420
Applicant	Serial Podcast, LLC
Applied for Mark	SERIAL
Correspondence Address	SEAN C FIFIELD LOCKE LORD LLP 111 S WACKER DR CHICAGO, IL 60606-4302 UNITED STATES ipdocket-chi@lockelord.com
Submission	Appeal Brief
Attachments	SERIAL word mark TTAB Brief.PDF(98245 bytes)
Filer's Name	Sean C. Fifield
Filer's e-mail	ipdocket-chi@lockelord.com
Signature	/Sean C. Fifield/
Date	01/17/2017

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re	: Service Mark Application of	:
		:
Applicant	: Serial Podcast, LLC	:
		:
Mark	: SERIAL	: Examining Attorney
	:	: Colleen Dombrow
Serial No.	: 86454420	:
	:	:
Filed	: November 14, 2014	: Attorney Docket No. 1007642.00003

APPLICANT'S APPEAL BRIEF

Sean C. Fifield
David T. Van Der Laan
LOCKE LORD LLP
111 S. Wacker Drive
Chicago, Illinois 60606
(312) 443-0700
ATTORNEYS FOR APPLICANT

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Applicant, Serial Podcast, LLC (“Applicant”), appeals to the Trademark Trial and Appeal Board from the Examining Trademark Attorney’s (the “Examining Attorney”) March 22, 2016 issuance of a final refusal to register the service mark SERIAL (“Applicant’s Mark”).

I. THE GROUNDS FOR FINAL REFUSAL

The Examining Attorney has refused registration of Applicant’s Mark in connection with “entertainment in the nature of an ongoing audio program featuring investigative reporting, interviews, and documentary storytelling,” on the basis that Applicant’s Mark purportedly is generic or, in the alternative, merely descriptive under Trademark Act Section 2(e)(1) (15 U.S.C. § 1052(e)(1)). Applicant has complied with all requirements made by the Examining Attorney which are not the subject of this appeal.

II. SUMMARY OF THE PROSECUTION HISTORY

This appeal relates to Applicant’s November 14, 2014 Application to register the mark SERIAL for use in connection with “entertainment in the nature of an ongoing audio program featuring investigative reporting, interviews, and documentary storytelling.” November 14, 2014 Application, TSDR p. 1. In an Office Action dated February 10, 2015, the Examining Attorney refused registration on the basis that Applicant’s Mark is purportedly merely descriptive because it “immediately describes a feature or characteristic of the applicant’s audio program in that it features a story in separate parts over a period of time.” February 10, 2015 Office Action, TSDR p. 1. The Examining Attorney also stated in passing that Applicant’s Mark “appears to be generic in connection with the identified services,” but did not cite genericness as a basis for refusing registration. *Id.* Applicant responded by asserting a claim of acquired distinctiveness under Trademark Act Section 2(f) (15 U.S.C. § 1052(f)) and pointing out that the mark was not generic. August 10, 2015 Office Action Response, TSDR p. 6. To support the Section 2(f)

claim of acquired distinctiveness, Applicant submitted evidence of widespread recognition of the term “SERIAL” as a source identifier for Applicant’s services in the form of an Affidavit of Ira Glass and attachments thereto. *Id.* at p. 11 (the “Glass Aff.”).

In an Office Action dated September 1, 2015, the Examining Attorney refused to register Applicant’s Mark on the basis that it purportedly is generic. September 1, 2015 Office Action, TSDR p. 1. In the alternative, the Examining Attorney maintained and continued the refusal to register based on mere descriptiveness. *Id.* Applicant responded, arguing that the Examining Attorney’s evidence was insufficient to carry the burden of proving genericness. March 1, 2016 Office Action Response, TSDR p. 1. Applicant’s response also continued its Section 2(f) claim of acquired distinctiveness and included supplementary evidence of acquired distinctiveness in the form of an Affidavit of Elise Bergerson and attachments thereto. *Id.* at p. 2 (the “First Bergerson Aff.”).

In a Final Office Action dated March 22, 2016, the Examining Attorney made final the refusal under Section 2(e)(1), concluding that Applicant’s Mark is generic or, in the alternative, merely descriptive without secondary meaning. March 22, 2016 Final Office Action, TSDR p. 1. On September 22, 2016, Applicant filed a request for reconsideration, again arguing that the Examining Attorney had failed to carry the burden of proving genericness, continuing the Section 2(f) claim of acquired distinctiveness, and providing further supplementary evidence of acquired distinctiveness in the form of a second Affidavit of Elise Bergerson and accompanying attachments. September 22, 2016 Request for Reconsideration, TSDR p. 3 (the “Second Bergerson Aff.”). The Examining Attorney denied Applicant’s request on November 14, 2016 on the basis that Applicant’s request for reconsideration “has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to

the outstanding issue(s) in the final Office Action” and that Applicant’s “analysis and arguments are not persuasive nor do they shed new light on the issues.” November 14, 2016 Reconsideration Letter, TSDR p. 1.

III. STATEMENT OF FACTS

Applicant began providing audio programs in the nature of podcasts under the SERIAL mark at least as early as September 19, 2014. Glass Aff. at ¶ 4. The first season of the SERIAL podcast ran for just over two months in late 2014. *Id.* at ¶¶ 5-6. The podcast debuted as the top podcast in the United States and for the entire season remained the number one podcast on the iTunes charts. *Id.* at ¶ 6. Applicant’s SERIAL podcast reached 5 million downloads faster than any other podcast in iTunes history. *Id.* at ¶ 8. During the first season, downloads of the SERIAL podcast were generally in excess of 200,000 per day and reached as high as 1.4 million downloads per day. *Id.* at ¶ 9.

Season two of Applicant’s SERIAL podcast ranked number one on the iTunes charts for all but one day from its debut on December 10, 2015 to March 1, 2016. First Bergerson Aff. at ¶ 6. During the second season, downloads of the SERIAL podcast generally exceeded 570,000 per day and reached as high as 1.7 million per day. *Id.* at ¶ 8. As of September 21, 2016, consumers had downloaded episodes of Applicant’s SERIAL podcast over 240 million times, with over 172 million downloads in the United States. Second Bergerson Aff. at ¶ 5.

According to Google Trends data—which shows the relative volume of consumer searches for a particular term over time—Google Internet searches for the phrase “podcast serial” in the U.S. were minimal during the ten years prior to the debut of Applicant’s SERIAL podcast. Glass Aff. at ¶ 11; Second Bergerson Aff. at ¶ 10. Following the launch of the

SERIAL podcast, searches for “podcast serial” increased substantially, as shown by a large spike over previous levels, which were nominal. Glass Aff. at ¶ 11.

Since October 2014, Applicant’s SERIAL podcast has been mentioned in over 12,000 media stories. Second Bergerson Aff. at ¶ 7. These stories include pieces regarding the scope and nature of SERIAL podcast fandom. *Id.* References to the SERIAL podcast appeared in such media outlets as the *New York Times*, *Washington Post*, *Wall Street Journal*, *LA Times*, *NBC News*, *ABC News*, *The Today Show*, *The New Yorker*, *The Atlantic*, *The Boston Globe*, *The Guardian*, *Le Monde*, *Der Spiegel*, *Vogue*, *Rolling Stone*, *Entertainment Weekly*, *Forbes*, *People*, *Time*, *New York Magazine*, *Salon*, *Slate*, *Buzzfeed*, *Wired*, *Us Weekly*, *Variety*, and *USA Today*. First Bergerson Aff. at ¶ 10. Media coverage has included adjectival descriptors such as “Serial-like” and “Serialesque” to nominatively identify Applicant’s trademark. Glass Aff. at ¶ 16. Applicant is not aware of any instances in which media coverage of Applicant’s SERIAL podcast included an explanation that the use of the term “SERIAL” was intended as a reference to the SERIAL podcast rather than as a generic reference to a type of audio program. First Bergerson Aff. at ¶ 11.

Applicant’s SERIAL podcast has become a high-profile aspect of American culture. The SERIAL podcast been parodied on an episode of *Saturday Night Live*, the subject of a controversial Best Buy tweet, mentioned in a *New Yorker* cartoon, and referenced by *Sesame Street*. Glass Aff. at ¶ 14. Applicant and its SERIAL podcast have given rise to multiple third-party parodies, such as a WNYC podcast about “true crime” events surrounding an office refrigerator and a CEREAL podcast discussing and commenting upon Applicant’s podcast. *Id.* at ¶ 19 and Exhibit E. Applicant has addressed and curtailed multiple unauthorized attempts by third parties to sell products or services bearing the SERIAL mark. *Id.* at ¶¶ 20-21.

IV. ARGUMENT

A. Applicant's Mark Is Not Generic

The primary rationale for the Final Refusal is that the Applicant's Mark is not registerable on the grounds that it is generic. Generic terms are terms that the relevant purchasing public understands **primarily** as the common or class name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344 (Fed. Cir. 2001). A generic mark can never function as a mark, no matter the amount of use the applicant makes or the amount of money the applicant spends on advertising and promotion, because generic terms are incapable of indicating a particular source of goods or services. *See Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 965 (Fed. Cir. 2015). This distinguishes generic marks from descriptive marks (which describe a feature or characteristic of the goods or services), because a descriptive mark can indicate source if it has acquired secondary meaning. *In re Dial-A-Mattress*, 240 F.3d at 1347.

Because the consequences of a genericness finding are so extreme, the Federal Circuit requires a "substantial showing by the Examining Attorney that the matter is in fact generic . . . based on the clear evidence of generic use." *In re American Fertility Society*, 51 U.S.P.Q. 1832 (Fed. Cir. 1999). If there is any doubt as to whether a mark is generic, such "doubts are to be resolved in the favor of the applicant." J. Thomas McCarthy, *MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION*, § 12:57; *In re Bel Paese Sales Co.*, 1 U.S.P.Q.2d 1233 (T.T.A.B. 1986); *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1571 (Fed Cir. 1987).

Here, the Examining Attorney did not meet the burden of proof to show that "SERIAL" is a term that the relevant purchasing public understands primarily as the common name for audio programs or podcasts. The majority of the Examining Attorney's evidence shows use of

the term “SERIAL” descriptively to identify a *characteristic* of an audio program, rather than to refer to an audio program or even the subcategory of audio programs called podcasts. Thus, the Examining Attorney primarily relied upon evidence demonstrating that the term “SERIAL” sometimes is used to describe a characteristic of an entertainment service rather than as a reference to a class of services. Accordingly, the Examining Attorney has merely demonstrated that the SERIAL mark is descriptive, which Applicant has conceded by its assertion of a Section 2(f) claim of acquired distinctiveness.

Under TMEP § 1209.01(c)(1), the following two-part test is used to determine whether a designation is generic: (1) What is the class of goods or services at issue?; and (2) Does the relevant public understand the designation primarily to refer to that class of goods or services? *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 990 (Fed Cir. 1986).

i. The class of services at issue

Here, the Examining Attorney considers the class of services at issue to be entertainment in the nature of an ongoing audio program, as set forth in Applicant’s application. Applicant notes that this type of audio program is generally referred to as a podcast. Applicant concurs with the Examining Attorney’s assessment that the class of services at issue is “entertainment in the nature of an ongoing audio program featuring investigative reporting, interviews, and documentary storytelling.”

ii. Public perception of the relevant term

To satisfy the second part of the genericness test, the relevant public must understand the term to primarily refer to that class of services. Applicant concurs with the Examining Attorney’s assessment that the relevant public consists of ordinary customers who purchase and listen to audio programs.

This part of the test turns upon the **primary** significance that the term would have to these consumers. *See Ty Inc. v. Softbelly's Inc.*, 353 F.3d 528 (7th Cir. 2003) (stating that the “primary significance” of the term is the legal test of genericness). The public’s perception is the primary consideration in determining whether a term is generic. *Loglan Inst. Inc. v. Logical Language Group Inc.*, 22 U.S.P.Q.2d 1531, 1533 (Fed. Cir. 1992). Thus, if the public regards the term as a trademark for certain goods or services, then that term would principally be a trademark. *See Stix Prods., Inc. v. United Merchants & Mfrs., Inc.*, 295 F.Supp. 479 (S.D.N.Y. 1968). Evidence of the public’s understanding of a term can be obtained from any competent source, including dictionary definitions, research databases, newspapers, and other publications. *See In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556 (Fed. Cir. 1985).

The Examining Attorney’ evidence falls well short of showing that the term SERIAL is primarily understood by the relevant public to be synonymous with entertainment services, podcasts, or even an “ongoing audio program.” Instead, the evidence produced by the Examining Attorney demonstrates that the word “serial” is used and recognized by the public primarily as a descriptive characteristic of certain entertainment services. For example, the Examining Attorney identified the following usages of the word “serial” in connection with entertainment in the form of podcasts:

Quote	Generic Term	Time Frame
“ <i>Alice Isn’t Dead</i> , a new serial fiction podcast from the team behind <i>Welcome to Night Vale</i> .” nightvale.libsyn.com (emphasis added). March 22, 2016 Office Action, TSDR p. 34.	Podcast	2015
“A special presentation of my sword & sorcery serial podcast , SKALD!” www.sticher.com (emphasis added). March 22, 2016 Office Action, TSDR p. 35.	Podcast	Unclear

Quote	Generic Term	Time Frame
“ Podcast Rec No. 1: ‘The Black List Table Reads . . . Written during the 2008 Writer’s Strike, Balls Out is an insane comedy with some of the raunchiest and obscene comedy that has been put on paper . . . Originally following the four-part serial format , it was edited and re-released as one audio for non-stop laughter.” dallascomedyhouse.com (emphasis added). March 22, 2016 Office Action, TSDR p. 36.	Podcast	2015
“ Podcasts can be either books like <i>Earthcore</i> by Scott Sigler or done in serial format such as <i>Pod of Horror</i> .” www.monsterlibrarian.com (emphasis added). March 22, 2016 Office Action, TSDR p. 37.	Podcast	Unclear
“ PODCAST . . . Back to the Future Lets Play – Episode 5 Part 4 . . . Joins us as we track through the Back to the Future Game, in a weekly serial format . Episodes out on Saturdays and Sundays.” highwaytomars.com (emphasis added). March 22, 2016 Office Action, TSDR p. 38.	Podcast	2015
“A podcast is a digital audio file about a specific topic that is released in a serial format for download to a computer or personal device.” ww.nuigalway.ie (emphasis added). March 22, 2016 Office Action, TSDR p. 43.	Podcast	Unclear
“What do you think about the resurgence of the classic radio serial format in the podcast era?” www.detroitnews.com (emphasis added). March 22, 2016 Office Action, TSDR p. 44.	Podcast	2015
“What are you most excited about in public radio or podcasting ? . . . Also I’m excited about the serial format generally. I’m listening out for the big return of radio drama.” blog.prx.org (emphasis added). March 22, 2016 Office Action, TSDR p. 45.	Podcasting	2015
“This podcast is recorded in a serial format and intended to be listened to sequentially.” aknightadrift.com (emphasis added). November 14, 2016 Reconsideration Letter, TSDR p. 2.	Podcast	2015
“ Podcasts are simply radio shows done online, but they’re mostly bored teenagers talking about themselves. . . . <i>The River of Crime</i> is presented in serial format , though it’s more of an anthology series with a common narrator than a single story.” www.residents.com (emphasis added). November 14, 2016 Reconsideration Letter, TSDR p. 3.	Podcast	2006
“bbbshow podcast To listen to an audio podcast , mouse over the title and click Play. . . . Just what is the Buffalo Bayou Show? Basically, it’s a collection of short stories in serial format .” itunes.apple.com (emphasis added). November 14, 2016 Reconsideration Letter, TSDR p. 4.	Podcast	2016

All of these uses of the word “serial” are descriptive. They describe an attribute of a podcast. These uses are all in the form of adjectives that modify a noun. These uses demonstrate only that the word serial may be descriptive of a format for a podcast. They do not come close to proving that the word “serial” means an ongoing investigative journalism and documentary storytelling program. Indeed, they do not prove that “serial” means “podcast.” Instead, they show that the generic term for the services at issue is “audio program” or “podcast,” which can be modified by the descriptive term “serial” when describing certain program formats.

The Examining Attorney’s evidence unrelated to podcasts also does not show that the relevant public **primarily** understands the term “serial” as describing the genus of Applicant’s services. For example, the Examining Attorney cited the following evidence:

Quote	Generic Term	Time Frame
“[S]tudents and faculty have conceived, written, and produced a serial radio drama about AIDS that is currently being broadcast throughout the African continent” www.brooklyn.cuny.edu (emphasis added). February 10, 2015 Office Action, TSDR p. 11.	Radio Drama	2002
“The Radio Movement presents adapted radio serial classics . . .” www.pulicaccesstheatre.org (emphasis added). February 10, 2015 Office Action, TSDR p. 13.	Classics	Unclear
“In Niger, the state television station and UNICEF have joined forces to produce a serial drama entitled ‘Soueba’ which focuses on the lives of young people in Niamey, Niger’s capital. www.nytimes.com (emphasis added). February 10, 2015 Office Action, TSDR pp. 15-16.	Drama	2010
“Each <i>Chuckanut Radio Hour</i> features . . . an episode of ‘The Bellingham Bean’ serial radio comedy . . .” www.villagebooks.com (emphasis added). February 10, 2015 Office Action, TSDR p. 20.	Radio Comedy	2014
“McQuade, though, is most famous for playing Rosalie on the CBS version of <i>The Goldbergs</i> , which began in 1928 as a daily serial drama on radio.” www.hollywoodreporter.com (emphasis added). February 10, 2015 Office Action, TSDR p. 24.	Drama	1928
“Originally, Sky King was a dialy 15-minute serial radio episode . . .” www.midatlanticnostalgiaconvention.com (emphasis added). February 10, 2015 Office Action, TSDR p. 39.	Radio Episode	1947

Quote	Generic Term	Time Frame
“How to write a radio serial drama for social development: a script writers manual. . . . This book is a practical manual for script writers preparing radio serial dramas for development projects. . . . Enter-Educate serial dramas combine entertainment and education in a format that can be highly attractive to a listening audience.” www.eldis.org (emphasis added). September 1, 2015 Office Action, TSDR p. 15.	Drama(s)	1996
“Audition set Saturday for actors to perform serial radio drama An open audition for the serial radio drama “Minutaie” will be held from noon to 3 p.m. Saturday at the United Methodist Church, 247 Golf Course Road.” The Daily Gazette, February 11, 2016 (emphasis added). March 22, 2016 Office Action, TSDR p. 1.	Radio Drama	2016
“ Serial Radio Dramas and Situational Comedies. . . . Serial dramas were set up to attract and keep audiences by weaving the same or similar storylines from episode to episode While the genres differed in their delivery, both serial dramas and situational comedies had one thing in common: the idea of the centralized character. . . . Typically 15 minutes in length, serial dramas and situational comedies usually stuck to a prescribed format.” entertainment.howstuffworks.com (emphasis added). March 22, 2016 Office Action, TSDR pp. 21-22.	Radio Dramas Dramas	Unclear
“The popularity of the soap opera and the serial drama proved that daytime radio had a devoted audience and could be extremely profitable for sponsors whose products appealed to these listeners.” memory.loc.gov (emphasis added). March 22, 2016 Office Action, TSDR p. 27.	Drama	1941
“Radio Serial Dramas All PMC radio serial dramas are produced according to PMC’s methodology, an adaptation of the Sabido methodology. . . . After more than 15 years of producing radio serial dramas on a variety of issues, PMC has produced more than 50 radio serial dramas and has provided training and advising about how to use PMC’s methodology to assist other serial dramas for social change.” www.populationmedia.org (emphasis added). March 22, 2016 Office Action, TSDR p. 29.	Dramas	Unclear
“Entertainment-education radio serial drama and outcomes related to HIV testing in Botswana. . . . Makgabaneng is an entertainment-education radio serial drama written and produced in Botswana to promote prevention of HIV. . . . Broadcast of the serial drama began in August 2001, and two new 15-minute episodes air each week.” www.ncbi.nlm.nih.gov (emphasis added). March 22, 2016 Office Action, TSDR p. 32.	Drama	2001

All of these uses of the term “serial” are descriptive, denoting a characteristic of generic terms like “radio drama,” “radio comedy,” “radio episode,” or “drama.” In each of these references, the word “serial” describes the ongoing narrative nature of a class of programs, rather than identifying the class of programs itself.

To the extent the Examining Attorney adduced evidence of references utilizing the term “serial” as a noun, the references are antiquated and archaic, referring to decades-old entertainment genres that are unlikely to affect the relevant public’s primary perception of the term in the podcast era. The following table contains examples of the antiquated uses appended by the Examining Attorney:

Quote	Generic Term	Time Frame
“Radio’s most popular and longest running national serial was One Man’s Family . . .” www.otrr.org (emphasis added). February 10, 2015 Office Action, TSDR p. 18.	Serial	1932-1959
“Airing over WJR, the radio serial featured the exploits of Scoop, played by Kasem, and his grandfather as they traveled the world in search of stories for the town newspaper.” www.detroitkidshow.com (emphasis added). February 10, 2015 Office Action, TSDR p. 37.	Serial	1940s
“Challenge of the Yukon began as a 15-minute serial airing locally on Detroit radio station WXYZ from 1938 until May 26, 1947 . . .” www.sergeanpreston.com (emphasis added). September 1, 2015 Office Action, TSDR p. 22.	Serial	1938-1955
“Regional authors also tend to be popular and Philip Solem recently published a story that he originally wrote and read as a serial on radio KAXE in the late 1980s.” <i>Read to Keep Your Brain Active</i> , The Journal, February 16, 2016 (emphasis added). March 22, 2016 Office Action, TSDR p. 1.	Serial	1980s
“1981 . . . , Star Wars is adapted for American public radio, as a 13-episode serial .” Idato, Michael, <i>Star Wars Year by Year</i> , The Age, December 11, 2015 (emphasis added). March 22, 2016 Office Action, TSDR p. 1.	Serial	1981
“The doughy hero of the BBC’s first daily radio serial , <i>Dick Barton – Secret Agent</i> , running from 1945 to 1951.” search.credoreference.com (emphasis added). March 22, 2016 Office Action, TSDR p. 19.	Serial	1945-1951

Quote	Generic Term	Time Frame
“The English detective-novelist created by Francis Durbridge for the radio serial <i>Send for Paul Temple</i> (1938) and its many sequels broadcast over the next 30 years.” search.credoreference.com (emphasis added). March 22, 2016 Office Action, TSDR p. 20.	Serial	1938
“It began as a radio serial in 1978 and was later successfully adapted for television.” search.credoreference.com (emphasis added). March 22, 2016 Office Action, TSDR p. 26.	Serial	1978

While the Examining Attorney also cites a few modern examples of generic usage of “serial,” *see, e.g.*, September 1, 2015 Office Action, TSDR p. 25, this usage is infrequent and sporadic and therefore not indicative of the public’s understanding at the time of the submission of the application. The modest number of obscure, non-adjectival uses cited by the Examining Attorney pale in comparison to the voluminous, recent and prominent usage of the term “SERIAL” in a descriptive manner to reference a characteristic of an audio program. The Examining Attorney is required to demonstrate that the relevant public **primarily** perceives the term as generic rather than descriptive. The limited generic usage evidence adduced by the Examining Attorney does not outweigh the far more abundant, recent, and probative evidence of its use as a descriptive term. The evidence in the record relating to third-party usage of the term “SERIAL” therefore demonstrates that use of the term is primarily to identify a characteristic of an audio program, rather than to refer to either audio programs or podcasts (the subcategory of audio program made available by the Applicant).

When the record of the public usage of the term “SERIAL” in the context of Applicant’s own audio program is considered, the record overwhelmingly demonstrates that the relevant public understands the term “SERIAL”—applied to Applicant’s services—to be descriptive of a

characteristic of (and, pursuant to Section 2(f), distinctive of the source of) Applicant's podcast entitled "Serial."¹

Since its debut in October 2014, over 12,000 media stories have referred to Applicant's SERIAL podcast, necessarily using the term SERIAL as a source indicator rather than as a generic reference to "an audio program that is broadcast in separate parts over a period of time." First Bergerson Aff. at ¶ 9. Many of these references were made by wide-reaching media outlets, including the *New York Times*, *Washington Post*, *Wall Street Journal*, *LA Times*, *NBC News*, *ABC News*, *The Today Show*, *The New Yorker*, *The Atlantic*, *The Boston Globe*, *The Guardian*, *Le Monde*, *Der Spiegel*, *Vogue*, *Rolling Stone*, *Entertainment Weekly*, *Forbes*, *People*, *Time*, *New York Magazine*, *Salon*, *Slate*, *Buzzfeed*, *Wired*, *Us Weekly*, *Variety*, and *USA Today*. *Id.* at ¶ 10. If the SERIAL mark were primarily perceived as a generic term (as alleged by the Examining Attorney), it would be natural—even necessary—for such publications to include some explanation that their use of the term SERIAL is intended as a reference to the SERIAL podcast rather than as a generic reference to a certain type of audio program. Applicant, however, is not aware of any instances in which such an explanation was included in the extensive media coverage. *Id.* at ¶ 11. For example, if Applicant had adopted a generic term like AUDIO PROGRAM or PODCAST as the title of its podcast, the news coverage would necessarily explain to the reader that references to these terms in the news coverage are in fact references to the title of the work in question.

The thousands of references to Applicant's Mark in various widely circulated publications illustrate the public's understanding of the term SERIAL. *See In re Northland*, 777 F.2d 1556, 1559 (Fed. Cir. 1985) (usage of BUNDT in popular media such as *The Good*

¹ The Board should consider Applicant's evidence along with the evidence appended by the Examining Attorney. *See In re Bayer Aktiengesellschaft*, 488 F.3d 960, 967 (Fed Cir. 2007) (noting that the Board considered Applicant's evidence in the record).

Housekeeping Cookbook demonstrated the public’s understanding of the term). The references to trademark use of the term “SERIAL” to identify Applicant’s audio program overwhelm the Examining Attorney’s evidence, the majority of which evidence, as discussed above, in fact demonstrates use in a descriptive manner rather generic use of the term. The Examining Attorney has not attempted to introduce any evidence to rebut Applicant’s evidence of the fame of the Applicant’s SERIAL podcast and the recognition by the public of the term SERIAL as an identifier of Applicant’s particular podcast, as opposed to a generic term.

While the Examining Attorney’s evidence may support the contention that the term “SERIAL” is descriptive of the nature of the podcast, the evidence is insufficient to qualify as a substantial showing that the term is generic. Moreover, the evidence submitted by the Examining Attorney in support of her contention is thoroughly rebutted by the ample evidence submitted by Applicant demonstrating current public perception of the term SERIAL, as used by Applicant, as a service mark identifying the source of the SERIAL podcast.

In any event, where there is evidence of multiple uses of a term, both generic and non-generic, the Examining Attorney cannot sustain the high burden of proving genericness. *See Merrill Lynch*, 828 F.2d at 1571 (finding that a mixture of generic and non-generic usages in the record did not show that the term CASH MANAGEMENT ACCOUNT was generic). At a minimum, these multiple uses create doubt as to whether the term “SERIAL” is generic, and any such doubt must be resolved in Applicant’s favor. *See In re Bel Paese*, 1 U.S.P.Q.2d at 1233 (resolving doubt as to genericness “by publishing the mark and allowing any person who believes he would be damaged by the registration of the mark to file an opposition”). Accordingly, the SERIAL mark is not generic as applied to Applicant’s services and is fully capable of functioning as—indeed already is—a source identifier for Applicant’s services.

B. Applicant's Mark Has Acquired Distinctiveness

The Examining Attorney hedged the genericness finding by also concluding that SERIAL is descriptive and lacks secondary meaning (and thus acquired distinctiveness). The descriptiveness conclusion is accurate, but the conclusion about acquired distinctiveness is erroneous. It appears the Examining Attorney based the assessment of Applicant's evidence of acquired distinctiveness on the previous determination that Applicant's Mark is generic. This approach led the Examining Attorney to ignore overwhelming evidence that Applicant's Mark acquired secondary meaning.

Several factors are relevant to determining whether a mark has acquired secondary meaning, including: (1) the length and exclusivity of the mark's use; (2) advertising expenditures; (3) sales success; (4) unsolicited media coverage of the product; (5) consumer studies linking the mark to a source; and (6) attempts to plagiarize the mark. *See In re Steelbuilding.com*, 75 U.S.P.Q.2d 1420, 1424 (Fed. Cir. 2005). In support of the proposition that Applicant's Mark is a symbol of origin which identifies Applicant and as evidence of acquired distinctiveness, Applicant submitted the Glass Affidavit and the Bergerson Affidavits, all of which set forth evidence showing the duration, extent, and nature of Applicant's use of the SERIAL mark in commerce, as well as the public's perception of the mark.

Applicant has provided audio programs in the nature of podcasts under the SERIAL mark since at least as early as September 19, 2014. Glass Aff. at ¶ 4. The first season of the podcast offered under the SERIAL mark ran for just over two months, and was an immediate event in pop culture. *Id.* at ¶¶ 5-6. For the entire season, the podcast remained number one on the iTunes charts. *Id.* at ¶ 6. In fact, Applicant's SERIAL podcast reached 5 million downloads faster than any other podcast in iTunes history. *Id.* at ¶ 8. During the first season, daily downloads of the

SERIAL podcast were generally in excess of 200,000 and reached as high as 1.4 million downloads. *Id.* at ¶ 9.

The second season of the SERIAL podcast ranked number one on the iTunes charts for all but one day from its debut on December 10, 2015 through March 1, 2016. First Bergerson Aff. at ¶ 6. During the second season, daily downloads of the SERIAL podcast generally were in excess of 570,000 and reached as high as 1.7 million. *Id.* at ¶ 8. In total, as of September 21, 2016, episodes of Applicant’s SERIAL podcast had been downloaded over 240 million times. Second Bergerson Aff. at ¶ 5. This overwhelming sales success² strongly supports secondary meaning. *See In re Steelbuilding.com*, 75 U.S.P.Q.2d at 1424 (sales success is evidence of secondary meaning).

For the 10 years prior to the debut of Applicant’s SERIAL podcast, Google Internet searches for the phrase “podcast serial” in the U.S. were essentially non-existent. Glass Aff. at ¶ 11. Following the launch of the SERIAL podcast, searches for “podcast serial” spiked despite the prior existence of other podcasts that were broadcast in separate parts over a period of time. *Id.* This spike shows that the public did not associate the term “SERIAL” with podcasts until after the debut of Applicant’s SERIAL podcast. Indeed, the spike indicates that—in the minds of the relevant public—Applicant essentially coined the term “SERIAL” as applied to podcasts.

Consumer recognition of the term “SERIAL” as a mark and source identifier for Applicant and Applicant’s podcast was so vast and significant that Applicant’s SERIAL podcast became the subject of numerous unsolicited media stories. *See In re Steelbuilding.com*, 75 U.S.P.Q.2d at 1424 (unsolicited media coverage of the product or service supports a finding of secondary meaning). In the 18 months following its debut, Applicant’s SERIAL podcast was

² Podcasts are distributed through downloads, which can be either free or involve a payment. Like most podcasts, Applicant’s SERIAL podcast is available for download without charge. Second Bergerson Aff., ¶ 6, Ex. A. Accordingly, Applicant’s sales are not measured in dollar amounts, but rather by the number of downloads.

mentioned in over 12,000 media stories. First Bergerson Aff. at ¶ 9. Some of those stories dealt directly with the nature of SERIAL podcast fandom. Second Bergerson Aff. at ¶ 7. Applicant's SERIAL podcast has even been the basis of a *Saturday Night Live* parody sketch, the subject of a controversial Best Buy tweet, mentioned in a New Yorker cartoon, and referenced by *Sesame Street*. Glass Aff. at ¶ 14. Such extensive media recognition of Applicant and the services offered under Applicant's Mark is a reflection of the pervasiveness of those services, which supports secondary meaning. *See In re Steelbuilding.com*, 75 U.S.P.Q.2d at 1424. Moreover, the use by the media of Applicant's Mark to identify the source of those services (without any requirement for explanation of the fact that the SERIAL mark was functioning as an identification of source of the services) demonstrates the widespread consumer recognition that the term "SERIAL" in fact functions as a mark identifying Applicant and Applicant's services. *See id.*

Indeed, consumer recognition of Applicant's SERIAL podcast and, in turn, the SERIAL mark, has become so well-known as to merit adjectival descriptors such as "Serial-like" or "Serialesque" in media coverage. Glass Aff. at ¶ 16. Such uses were meant to describe other audio programs (usually podcasts) as mimicking some of Applicant's SERIAL podcast's subject matter or storytelling approach. These repeated media uses would be of no value unless consumers recognized the SERIAL mark as indicative of Applicant and its SERIAL podcast.

In addition, Applicant had to address and curtail unauthorized attempts by third parties to sell products or services bearing the SERIAL mark. *Id.* at ¶¶ 20-21, Ex. F. For example, various third parties offered t-shirts and iPhone cases bearing the SERIAL mark or a confusingly similar mark for sale without Applicant's permission. *Id.* These unauthorized uses clearly were meant to connote Applicant and its services, as the third-party products and services related to or

mentioned details about Applicant and/or the services provided under the SERIAL mark, including the use of names and images of individuals central to the story told in the first season of Applicant's SERIAL podcast. *See* Glass Aff. at ¶¶ 20-21, Ex. F and G. These were efforts by third parties to trade off the goodwill Applicant has garnered in its mark, and the fact that these unauthorized uses associated the SERIAL mark with other aspect of Applicant's podcast further demonstrates the perception by the consuming public of the SERIAL mark as a source identifier of Applicant's services. *See In re Steelbuilding.com*, 75 U.S.P.Q.2d at 1424 (attempts to plagiarize a mark are indicative of secondary meaning).

Applicant's extensive use of the term "SERIAL" as a mark and the consuming public's perception of Applicant's Mark as identifying services provided by Applicant show that Applicant's Mark has acquired distinctiveness (and, incidentally, demonstrates that the mark is therefore not generic). In fact, the widespread fame and clear track record of Applicant's Mark in functioning as an identifier of source for the audio program in question rebuts any argument that the mark is generic because (1) it shows that the public's primary perception of the term "SERIAL" in the context of audio programs is as a source identifier for Applicant's SERIAL podcast and (2) a generic mark would, by definition, be incapable of playing such a role. Applicant's Mark is descriptive and has acquired distinctiveness. Therefore, it should be published pursuant to Section 2(f).

V. CONCLUSION

For the foregoing reasons, Applicant respectfully requests that this Board reverse the Examining Attorney's final refusal of registration and allow Applicant's registration to proceed to publication on the Principal Register.

Date: January 17, 2017

Respectfully submitted,

By: /Sean C. Fifield/

ATTORNEYS FOR APPLICANT

Sean C. Fifield
David T. Van Der Laan
LOCKE LORD LLP
111 S. Wacker Drive
Chicago, Illinois 60606
(312) 443-0700
sfifield@lockelord.com (S. Fifield)
dave.vanderlaan@lockelord.com (D. Van Der Laan)